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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

Q207-US1

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name _____Application Number
10/820,955Filed
April 7, 2004First Named Inventor
BERG, Paul et al.Art Unit
1795Examiner
WILLS, Monique

Applicant requests review of the final rejection in the above-identified patent application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 42,491☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____

Signature

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Typed or printed name

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Telephone number

03/12/2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below*.

☒ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Paul Berg

Serial No: 10/820,955

Filed: April 7, 2004

For: BATTERY CONNECTION STRUCTURE
AND METHOD



Art Unit: 1795

Examiner: WILLS, Monique

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Commissioner for Patents
P.O. Box 1450
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Pre-Appeal Brief Request for Review

This communication is in response to the Office Action mailed on December 10, 2008 (the pending Office Action). Claims 1, 11, 17 and 22 are the only independent claims that remain pending.

REMARKS

Claim 1

Independent Claim 1 stands rejected under 35 USC §103(a) as being unpatentable over U.S. Patent Publication No. 2004-0161662 (Kim).

Claim 1 recites that "a fastening device having a shaft passing through the gasket and the hole in the insulator member." Claim 1 further recites "the fastening device applying a pressure in an axial direction of the hole in the cover **to press the ... first electrode tab ... and the second electrode tab against each other.**"

Kim teaches an electrode terminal 330 extending through a gasket 320 and a hole in an insulating plate 250. However, nothing in Kim teaches or suggests that the electrode terminal applies pressure that presses a first electrode tab and the second electrode tab against each other. As a result, Kim does not teach or suggest every element of claim 1 and claim 1 is patentable over Kim.

The Applicant made this argument in the Response filed on February 4, 2008. In response, the subsequent Office Action mailed on May 15, 2008, stated that these arguments

were persuasive. As a result, the May 15, 2008 Office Action agrees that the cited art fails to teach or suggest each of the elements identified in the Applicant's prior amendment.

A proper obviousness rejection requires that the cited art teaches or suggests every element of the claims. This requirement has been set forth in case law with statements such as "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Although the recent Supreme Court case of *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007) has provided new standards for obviousness rejections, there is nothing in the *KSR* opinion that directly or indirectly overturned the requirement that the cited art teach or suggest every element of a claim properly rejected as obvious. Further, the Board of Patent Appeals and interferences continues to cite and apply this standard in decisions such as *Ex Parte H. Garrett Wada, and Matthew B. Murphy* (Appeal 2007-1925, decided on June 25, 2007). As a result, current law holds that an obviousness rejection is not properly supported unless the cited art teaches or suggests every element of the claims.

As noted above the Office Action mailed on May 15, 2008 concedes that Kim does not teach or suggest that the electrode terminal applies pressure that presses a first electrode tab and the second electrode tab against each other. As a result, Kim does not teach or suggest every element of the claims and the claim 1 and claim 1 is patentable over Kim.

Claim 11

Independent Claim 11 stands rejected under 35 USC §103(a) as being unpatentable over U.S. Patent Publication No. 2004-0161662 (Kim).

Claim 11 recites "a case cover defining a hole" and "a fastening device having a shaft passing through the hole." Claim 11 also recites "the fastening device applying a pressure in an axial direction of the hole to press ... electrode tabs against each other."

Kim teaches an electrode terminal 330 extending through a gasket 320 and a hole in an insulating plate 250. However, nothing in Kim teaches or suggests that the electrode terminal applies a pressure that presses electrode tabs against each other. As a result, Kim does not teach or suggest every element of claim 11 and claim 11 is patentable over Kim.

The Applicant made this argument in the Response filed on February 4, 2008. In response, the subsequent Office Action mailed on May 15, 2008, stated that these arguments were persuasive. As a result, the May 15, 2008 Office Action agrees that the cited art fails to teach or suggest “the fastening device applying a pressure in an axial direction of the hole to press ... electrode tabs against each other.” As a result, Kim does not teach or suggest every element claim 11 and claim 11 is patentable over Kim.

Claims 17 and 22

Independent Claims 17 and 22 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,579,640 (Nagase).

Independent Claims 17 and 22 each recite “one rivet mechanically coupling a first polarity electrode to a second polarity electrode.” Nagase teaches multiple positive electrodes coupled to a rivet. However, Nagase does not teach or suggest that the rivet couples electrodes of different polarities. For this reason alone, Nagase does not teach or suggest every element of claim 17 and 22. As a result, independent claims 17 and 22 are patentable over Nagase.

The Applicant made this argument in the Response filed on February 4, 2008. In response, the subsequent Office Action mailed on May 15, 2008, stated that the Applicant’s arguments were persuasive. As a result, the May 15, 2008 Office Action agrees that the cited art fails to teach or suggest “one rivet mechanically coupling a first polarity electrode to a second polarity electrode.” As a result, Nagase does not teach or suggest every element of claims 17 and 22. For this reason alone, independent claims 17 and 22 are patentable over Nagase.

Further, using a rivet to connect the different polarity electrode tabs disclosed in Figure 2 of Nagase (801a and 803a) would short circuit the battery. As a result, it would not be obvious for the Nagase electrodes to have opposite polarities. For this reason alone, independent claims 17 and 22 are patentable over Nagase.

Conclusion

The Applicant respectfully submits that legal error has been made in each of the above rejections. For these reasons, allowance of the currently pending claims is respectfully requested.

Respectfully submitted



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